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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,124	10/04/2004	Anders Dahlberg	HPX0088-PCT	6608

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/510,124

Applicant(s)

DAHLBERG, ANDERS

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/4/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, 11 and 12, drawn to a tool device.

Group II, claim(s) 6-10, drawn to a cutting tool.

2. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The invention of Group I lacks the special technical feature(s) of the cutting tool including the through hole and the curved edge portions.

The invention of Group II lacks the special technical feature(s) of the tool device including the tool housing and the damper unit.

3. During a telephone conversation with Ms. Jaclyn Schade on March 9, 2007, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5, 11 and 12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-10 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

5. The information disclosure statement filed on October 4, 2004 has been received and the references listed thereon have been considered.

Oath/Declaration

6. The filing date for the PCT application on page 2 appears to be inaccurate, and it appears that it should read --12 March 2003--.

Drawings

7. The drawings are objected to because of the following informalities:

In Figure 1, the lead line for the uppermost occurrence of "220" appears to be inaccurate since it does not appear to indicate a screw (e.g., compare with the other occurrence of "220").

In Figure 3, numeral 21 should be added for clarity; numerals 241 (two occurrences) and 242 are improper because they are used to indicate other features (e.g., see Figure 1).

In Figure 4, each occurrence of "261" appear to indicate different features which is improper.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Abstract

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

9. The abstract of the disclosure is objected to because the use of "said" in line 11 is improper. Appropriate correction is required. See MPEP § 608.01(b).

Specification

10. The disclosure is objected to because of the following informalities:

On page 3, line 37, "232" appears to be inaccurate, and it seems that it should read --233--.

On page 4, lines 24, 27 and 29, the use of "241" and "242" are improper since they have already been used to indicate other features (e.g., in the previous paragraph).

On page 5, line 6, it seems that --26-- should be inserted after "hatch" or the like for clarity; in line 8, the use of 242" is improper since it has already been used to indicate another feature; in line 11, "26" appears to be inaccurate, and it seems that it should read --261--.

Appropriate correction is required.

Claim Objections

11. Claims 1-5, 11 and 12 are objected to because of the following informalities:

In claim 1, line 5, the use of "the said" is improper.

In claim 2, line 3, the use of "the said" is improper.

In claim 4, lines 3 and 4, each use of "the said" is improper.

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In claim 5, lines 2-3, the use of "the said" is improper.

In claim 11, lines 3, 4, 6 and 8 (twice), the use of "the said" is improper.

In claim 12, line 2 (twice), the use of "the said" is improper.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In general, the configuration of the invention, particularly regarding the curved supporting surfaces, is not clearly disclosed and thus it is unclear as to exactly what structure is being claimed.

Claim Rejections - 35 USC § 112, 2nd paragraph

14. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, line 5, the recitation "the material thickness" lacks antecedent basis and is vague and indefinite as to what it refers (i.e., the material thickness of what?); in line 7, the recitation "the material thickness" lacks antecedent basis and is vague and indefinite as to what it refers.

In claim 12, line 2, the recitation "is less than the material thickness ..." renders the claim vague and indefinite since the invention is being positively defined in terms of the workpiece which is not part of the claimed invention.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindell, pn 4,470,330.

Lindell discloses a device with every structural limitation of the claimed invention including:

- a striking unit (e.g., 20),
- a tool housing (e.g., 25),
- a damper unit (e.g., 53, 55),
- a movable crosscutting tool (e.g., 26) and
- a fixed crosscutting tool (e.g. 27),

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characterized in that the said tool housing comprises a solid base element having a recess (e.g., see Figs. 2 and 3) designed for the said fixed crosscutting tool, the material thickness in the direction of impact measured from an upper edge of a supporting surface in the said recess (e.g., a top surface of 27) to an upper end surface of said base element (e.g., the topmost surface shown in Fig. 2, above numeral 36) being greater than the material thickness measured in a portion (e.g. the portion of the base between 53 and the rightmost or leftmost side; or the portion from the cavity in which 57 is located to the rightmost side) close to the said upper end surface of the said base element in the transverse direction relative to the direction of impact;

[claim 12] characterized in that the extent of the said recess in the direction of impact is less than the said material thickness in the direction of impact (e.g., as shown in Fig. 2).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-5, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindell, pn 4,470,330.

Regarding claims 1-5, Lindell discloses a device with almost every structural limitation of the claimed invention including:

a striking unit (e.g., 20),
a tool housing (e.g., 25, and alternately 25, 27),
a damper unit (e.g., 53, 55),
a movable crosscutting tool (e.g., 26 and/or the circular tool in the center thereof)
and
a fixed crosscutting tool (e.g., 27 and/or the circular tool in the center thereof),
characterized in that there is a recess (e.g., see Fig. 1) for a striking piston (11)
belonging to the striking unit (10);

[claim 2] characterized in that the tool housing is provided with a cylindrical
recess (e.g., in the center portion of 27) which recess is designed for arrangement of
the fixed crosscutting tool (50) inside the tool housing (20);

[claim 3 (from 2)] characterized in that the said cylindrical recess is disposed in a
homogenous base element belonging to the said tool housing (e.g., as shown in Figs. 2
and 3);

[claim 4 (from 3)] characterized in that coaxially with the said cylindrical recess
there is disposed an axially displaceable adjusting mechanism (e.g., 38) for axially
adjustable positioning of the said fixed crosscutting tool inside the said recess;

[claim 5 (from 3)] characterized in that a supporting member for the damper is
designed to be able to be anchored directly to the said base element (e.g., as shown in
Figs. 3 and 4).

Lindell lacks the tool housing having at least two curved supporting surfaces for
positioning of the movable crosscutting tool, which supporting surfaces have the same

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radius, and in that between the said supporting surfaces is the recess; and lacks the cylindrical recess in the housing having the same centre line and the same radius as the said supporting surfaces.

However, as best understood, it appears that it would have been an obvious matter of design choice to make the horizontal surfaces to the left and right of feature 30 curved since applicant has not disclosed that having such surfaces in a curved configuration solves any stated problem or is for any particular purpose, and it appears that the device of Lindell would perform equally well with the surfaces have a straight or curved configuration.

Conclusion


19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
March 19, 2007